UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,374	12/06/2005	Vladimir Portnykh	Q76716	3625

23373 7590 04/04/2008

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER	
QUELER, ADAM M	

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
04/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/559,374	PORTNYKH ET AL.	
	Examiner	Art Unit	
	ADAM M. QUELER	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-22,24-30 and 32-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-22,24-30 and 32-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 1/3/2008.

2. Claims 19-22, 24-30, 32-35 are pending in the case. Claims 19 and 25 are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 34 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While elements of the claimed subject matter appear throughout the specification, assets as described in claim 19 appear to be inconsistent with the assets described in claim 34. There also does not appear to be any support for code generation. Applicant has not pointed out where in the application as filed this claim has support, nor is it apparent.

5. Claims 34 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As described above, claim 34 appears to contradict both the specification and the independent claim. As such the scope of the claim cannot be determined. For examining purposes only, claim 34 will be rejected under the same rationale as its parent.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 19, 20, 22, 24-26, 28, 30 and 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Bergman (US006564263B1, 5/13/2003).**

Regarding independent claim(s) 19, Bergman teaches:

checking whether an asset for display (multimedia content) is comprised of one or more photo data and one or more audio data (col. 19, ll. 54-58, checks to see what the content is comprised, which in the normal course operation includes photo, image col. 8, ll. 28-36, and audio, col. 8, ll. 37-39);

extracting reference information needed for displaying the photo data and the one or more audio data from the asset; (description scheme, col. 19, ll. 54-55);

displaying the photo data and the one or more audio data, using the extracted reference information, based on a meta data including time information indicating time during which each piece of the photo data is displayed while the audio data is being provided (multimedia is displayed, col. 7, line 59, the multimedia is generated/synthesized according to (based on) intra-object relationships, col. 20, ll. 34-47, which includes a position and a time when the photo data is displayed (col. 6, ll. 53-56).)

Regarding independent claim(s) 25, Bergman teaches:

displaying the asset using the generated metadata (multimedia is displayed, col. 7, line 59, the multimedia is generated/synthesized according to (based on) intra-object relationships or meta-data, col. 20, ll. 34-47)

the asset is comprised of audio, (col. 8, ll. 37-39) and one or more photo data (image, col. 8, ll. 28-36) and is displayed by use of a asset corresponding to the reference information, wherein, the reproduction information comprises information on a time when the text data is displayed (metadata includes a time when the text data is displayed, col. 6, ll. 53-56). Inherently, this metadata must have been generated.

Regarding dependent claim(s) 20, 26, Bergman teaches a markup language (col. 14, ll. 3-29).

Regarding dependent claim(s) 22, 30, Bergman teaches identification information to identify the asset (annotations, col. 8, ll. 55-58).

Regarding dependent claim(s) 24, 32, Bergman teaches information on an attribute of an asset (annotations, col. 8, ll. 55-58).

Regarding dependent claim(s) 28, Bergman teaches the elements are defined by a schema (scheme, col. 18, ll. 63-67).

Regarding dependent claim(s) 33, Bergman teaches an instance of a class that comprises the audio data and still photo data ("Infopyramid", para. col. 8, ll. 10-19).

Regarding dependent claim(s) 34, as described above, this claim is rejected under the same rationale as its parent.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bergman.** **Regarding dependent claim(s) 29,** Bergman does not give the elements the exact names in the claims. However, the differences in the claimed invention are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. All the steps of the function would be performed the same way regardless of whether or not the name of the element is "AudioWithStill" or anything else (for example "AudImg"). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to call the elements any name

(including "AudioWithStill") because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

11. Claims 21 and 27are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergman as applied to claims 18 and 25above, and further in view of Applicant's Admitted Prior Art.

Regarding dependent claim(s) 21, 27, Bergman teaches the meta-data is described according to MPEG-7, a known standard (col. 14, ll. 4-8). Bergman uses this standard rather then MPV. Applicant admits that MPV was a known standard (para. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the MPV standard for the MPEG-7 standard because the substitution of one known element for another would have yielded predictable results (multimedia is still displayed according to the meta-data) to one of ordinary skill in the art.

12. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bergman as applied to claim 34 above, and further in view of Alvesalo, (US 20030222899 A1, 12/04/2003).

Regarding dependent claim(s) 35, Bergman does not explicitly disclose transitions. Alvesalo teaches defining the type of transition between assets (para. 27). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Alvesalo and Bergman to take advantage of advanced capabilities of hardware (Alvesalo, para. 27).

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 19-22, 24-30, and 32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-10 and 12-18 of copending Application No. 11/415,096. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding independent claim(s) 19, every element of the claim is anticipated by claim 9 of the co-pending application (which incorporates its parent, claim 5), except the co-pending claim is the method that carried out by the apparatus of the instant claim. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a computer (including a memory under control of a processor) to carry out the method of the co-pending claim, because a computer was one of several predictable finite solutions for implementing the method.

The remainder of the instant application's claims corresponds to the co-pending claims according to the table below, and differs from but is obvious from those claims for the same rationale as claim 19.

Instant	19	20	21	22	24	25	26	27	28	29	30	32
Co-pending	9	6	7	8	10	17	12	13	14	15	16	18

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 19-22, 24-30, and 32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-20 and 24-30 of copending Application No. 10/948,316. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding independent claim(s) 19, every element of the claim is anticipated by claim 19 of the co-pending application (which incorporates its parent, claim 15), except the co-pending claims teach videos displayed in relation to audio, while the instant application teaches photos displayed in relation to audio. It would have been obvious to one of ordinary skill in the art at the time of the invention to display photos in relation to audio instead of video, as they were both a form of multimedia intended to be displayed in conjunction with other multimedia, and would have received the same benefit by displaying them according to a temporal relationship.

The instant application's claims below correspond to the co-pending claims according to the table below, and differ from but are obvious from those claims for the same rationale as claim 19.

Instant	19	20	21	22	24	25	26	27	28	29	30	32
Co-pending	19	16	17	18	20	29	24	25	26	27	28	30

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 19-22, 24-30, and 32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 28, 30-34, 36-41 of copending Application No. 10/949,474. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding independent claim(s) 19, every element of the claim is anticipated by claim 28 of the co-pending application except the co-pending claims teach text displayed in relation to any multimedia, while the instant application teaches photos displayed in relation to audio. It would have been obvious to one of ordinary skill in the art at the time of the invention to display photos instead of text, in relation to audio instead of any multimedia, as they were all forms of multimedia intended to be displayed in conjunction with other multimedia, and would have received the same benefit by displaying them according to a temporal relationship.

The instant application's claims below correspond to the co-pending claims according to the table below, and differ from but are obvious from those claims for the same rationale as claim 19.

Instant	19	20	21	22	24	25	26	27	28	29	30	32
Co-pending	28	30	31	32	33	34	36	37	38	39	40	41

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 19-22, 24-30, and 32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-22, and 25-31of copending Application No. 10/949,253. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding independent claim(s) 19, every element of the claim is anticipated by claim 28 of the co-pending application except the co-pending claims teach photo displayed in relation to any video, while the instant application teaches photos displayed in relation to audio. It would have been obvious to one of ordinary skill in the art at the time of the invention to display photos in relation to audio instead of any video, as they were all forms of multimedia intended to be displayed in conjunction with other multimedia, and would have received the same benefit by displaying them according to a temporal relationship.

The instant application's claims below correspond to the co-pending claims according to the table below, and differ from but are obvious from those claims for the same rationale as claim 19.

Instant	19	20	21	22	24	25	26	27	28	29	30	32
Co-pending	21	18	19	20	22	30	25	26	27	28	29	31

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

18. Applicant's arguments filed 1/3/2008 have been fully considered but they are not persuasive.

Applicant alleges that Bergman does not specifically disclose an object having audio and photo data. Bergman teaches that objects are contemplated as being several different modalities, such as text, video, image (photo) and audio. Bergman teaches that that among the options are the claimed audio and image (photo). Therefore Bergman teaches an option that the objects described as having a spatial-temporal relation can be audio and image. Optional inclusion

teaches both embodiments that do and do not include the options. See MPEP 2123 I. As such, the limitation is anticipated.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM M. QUELER whose telephone number is (571)272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen S. Hong/
Supervisory Patent Examiner, Art Unit 2178

aq